REMARKS

The above amendment with the following remarks is submitted to be fully responsive to the Official Action of October 6, 2003. Reconsideration of this application in light of the amendment and the allowance of this application are respectfully requested.

Claims 1-36 were pending in the present application prior to the above amendment. In response to the Office Action, claims 1, 5-8, 12-15, 19-22, 25, 26, 28, 29, 31, and 34-36 have been amended, and new claims 37-48 have been added. Therefore, claims 1-48 are pending in the present application and are believed to be in proper condition for allowance.

Referring now to the Office Action, the Examiner rejected claims 1-2, 5-9, 12-16, and 19-21 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,487,557 to Nagatomo. The Applicants respectfully disagree and contend that Nagatomo does not anticipate claims 1-2, 5-9, 12-16, and 19-21. Nagatomo is directed to a network access management system that categorizes e-mail addresses and URLs accessed by a user based on frequency of historical use to allow generation and display of virtual reality maps using VRML. The end product of Nagatomo is shown in Fig. 17 of Nagatomo, where E-mail addresses and URLs are categorized based on frequency of historical use, and located on the virtual reality maps based on type of address/URL.

In contrast, claims 1-2, 5-9, 12-16, and 19-21 of the present application are directed to methods, computer program products, and computer systems for generating directed content based on the identity of remote web services that receive a given search term at high frequencies. Thus, one implemented embodiment of the invention is defined as a method including the steps of receiving a set of lists from a plurality of remote web services, each list associated with a respective web service and including searches submitted, distilling the set of lists into a frequency database obtaining a query, searching the frequency database for matches, selecting the matches having the

highest associated frequencies, and generating a directed content based on one or more of the selected web services.

Referring to the example provided on page 12 of Applicants' specification, the operation of the present invention using the search term "napster" is described. Using the method of the present invention, a determination is made that the web service "download.com" has received the search term "napster" with a relative frequency of 3853 whereas the web service "software.com" has received the same search term with a relative frequency of only 14. Therefore, the directed content, such as an advertisement, is generated based on the identity of the web service "download.com" (as opposed to "software.com") since "download.com" received the search term "napster" with the highest frequency. The directed content can be, for example, an advertisement to use "download.com."

Nagatomo does not disclose the presently rejected claims 1-2, 5-9, 12-16, and 19-21 since there are a number of elements of these claims that are not provided by Nagatomo. For example, Nagatomo does not teach or suggest receiving a set of lists of any kind from a plurality of remote web services and, more particularly, does not teach lists of search terms that have been submitted to a plurality of remote web services, such lists being specifically recited in the rejected claims. Since Nagatomo does not teach receiving a list of searches submitted to a respective web service, Nagatomo cannot possibly teach many of the other elements recited in claims 1-2, 5-9, 12- 16, and 19-21, such as distilling the set of lists into a frequency database, searching the frequency database for a match between the query and search terms in the database, or generating directed content based on one or more of the selected web services.

In particular, Nagatomo does not teach the receipt of lists from a plurality of remote web services, each list including searches submitted to a respective web service. Claims 1, 7, 8, 14, 15, and 21 recite that a set or plurality of lists are received from a plurality of remote web services. As described on page 6, lines 8-17, of Applicants' specification, remote web services, including "engines such as CNET's Shopper.com and Amazon.com's Lawn & Patio Store," send in lists to be aggregated into a database or a sorted list.

In complete contrast, as illustrated, for example, in Nagatomo's Fig. 11, a list of URLs accessed by users is built over time on access management server 110 (Nagatomo's Fig. 2) as the web sites are accessed. The lists shown in Nagatomo's Figs. 5 and 6, for instance, are not received from remote web services. Rather, these lists are generated by a network service provider, with data being added to a user's information (in the client database 120) as the user accesses various web sites. The portions of Nagatomo (col. 12, lines 32-46, col. 13, line 52 to col. 14, line 12, Fig. 6-Table 123) cited by the Examiner as being relevant to the receiving step of claim 1, concern the client database 120 and the information stored for each client. None of the data described in these portions of Nagatomo comprise lists received from web services, where the lists identify searches submitted to the web services, as required by independent claims 1, 8 and 15.

In Nagatomo, when a particular user enters a URL that the particular user has never entered before (elements S201-No, S203 of Nagatomo's Fig. 11), a record of this event is added to history table 122 (Nagatomo's Fig. 5) along with the user's identifier. When a particular user enters a URL that the particular user has entered before (elements S201-Yes, S202 of Nagatomo's Fig. 11), the access frequency for that URL is updated in a record in history table 122. In this way, each record in Nagatomo's history table 122 tracks the frequency that a particular URL has been accessed by a particular user associated with the record. History table 122 is used in Nagatomo to determine how URLs associated with a particular user in table 122 should be displayed on a client terminal associated with the user, i.e. to generate and display of virtual reality maps using VRML in the manner shown in Fig. 17 of Nagatomo.

In addition, Nagatomo does not teach a set of lists that includes searches submitted to web services. Even if Nagatomo were somehow construed to teach receiving a set of lists from a plurality of remote web services, Nagatomo does not teach that such lists would contain "searches submitted to said respective web services" as indicated in claims 1, 7, 8, 14, 15, and 21. Such "searches" are the search queries that are submitted to, for example, web search engines such as Google.com. They are illustrated in Applicants' Fig. 2 (search term 80-x-y), Fig. 3, Fig. 4 (user

provides query terms 410), page 11, lines 11-29, and page 14, lines 2-5, of the specification. Whereas Nagatomo does teach the storage of web addresses provided by a user, the web addresses of Nagatomo cannot be equated to Applicants' searches. Applicants' searches (*e.g.*, "napster", "presidential debate" from Applicants' page 11) represent *queries for information* whereas the web addresses of Nagatomo represent *connections to specific web sites*.

For the reasons discussed above, independent claims 1, 7, 8, 14, 15, and 21 are not anticipated by Nagatomo, and the withdrawal of this rejection of claims 1-2, 5-9, 12-16, and 19-21 is respectfully requested, claims 2, 5, 6, 9, 12, 13, 16, 19, and 20 being dependent on one of the noted independent claims. However, to facilitate prosecution of the present application, independent claims 1, 7, 8, 14, 15, and 21 have been further amended to specifically recite features that are clearly not disclosed, taught, or otherwise suggested by Nagatomo or other references relied upon by the Examiner.

In particular, these claims have been amended to recite that the plurality of remote web services are adapted to receive submissions of at least one search term and perform a search for the search term submitted. In addition, these claims have been amended to recite that the lists are maintained by the respective web services and each list includes search terms that were used by the respective web service to perform searches. These claims have also been amended to recite that the lists are distilled to provide search frequency information indicating the frequency with which each of the search terms were submitted for searching by the respective remote web service. Furthermore, the claims have been amended to recite that the matches indicate that he obtained query was submitted as a search term to the respective remote web service. Finally, these claims have also been amended to recite that the direct content is generated based on the remote services having the highest associated frequencies for the obtained query.

Clearly, the above features as recited in the independent claims 1, 7, 8, 14, 15, and 21 are not disclosed, taught, or otherwise suggested by Nagatomo or other

references of record. Therefore, in view of the remarks and amendments discussed above, the allowance of claims 1-2, 5-9, 12- 16, and 19-21 is respectfully requested.

Referring again to the Office Action, the Examiner also rejected claims 34-36 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,937,392 to Alberts. Applicants also respectfully traverse this rejection as well. One embodiment of Alberts is directed to an advertisement scheduler that determines the frequency by which advertisements are served. In particular, column 3, lines 22-25, of Alberts states that "[w]hen a user contacts one of web servers **12** with a query or a request for information, ad server **14** causes one or more ads to be served *along with* a response to that request" (emphasis added).

In contrast, claims 34-36 are directed to collecting data generated by a remote web service in response to the query, and generating a directed advertisement that *includes a portion of the response* in the advertisement. Thus, there is a fundamental difference between the disclosed embodiment of Alberts and Applicants' claims 34-36. In Applicants' claims 34-36, the directed advertisements include a portion of a response to a query directly in the advertisement whereas Alberts merely discloses providing an ad together with the response to the request for information. The specification of the present application illustrates the present concept in Page 15, lines 14-22:

> For example, consider a case in which the query provided by a user during processing step 410 is "Harry Potter" during a period of time in which "Harry Potter" is a component of the title of a best selling paperback book. In all likelihood, an on-line book service such as Amazon.com will receive a high score during processing step 414 as numerous users request information on "Harry Potter" books. By routing the query terms "Harry Potter" to the Amazon.com query engine, the titles of available Harry Potter books are obtained and used as the basis of an advertisement that is transmitted to the client computer browser 54 for display during processing step 418.

In Alberts, the advertisements do not include a portion of a response to a search query. As can be clearly seen in Fig. 3 of Alberts, one embodiment disclosed stores a database that includes advertisement identifiers 34 which, according to column 3, lines

37-41, is a URL or pointer to data (*e.g.*, graphical and/or textual object) that is to be provided to the user. Thus, it is clear that, in this embodiment of Alberts, the advertisements do not include a portion of the response to a search query, and that the advertisements are in fact *predetermined*, whereas the advertisements indicated in claims 34-36 of the present application are dynamically generated as a function of search query results. Column 7, lines 7-32, of Alberts describes another embodiment disclosed in Alberts in which advertisements are selected as a function of the query. However, these advertisements are obtained from tables and do not include a portion of a response to a search query as recited in claims 34-36 of the present application. As such, claims 34-36 are not anticipated by Alberts, and the Applicants respectfully request that the rejection to claims 34-36 be withdrawn.

Nonetheless, to expedite prosecution of the present application, claims 34-36 have been amended above to specifically recite that directed advertisement generated includes a portion of the response within the advertisement. Clearly, the cited Alberts reference also fails to disclose, teach, or otherwise suggest this limitation as claimed. Therefore, the allowance of claims 34-36 is also respectfully requested.

Referring again to the Office Action, the Examiner rejected claims 3-4, 10-11, 17-18, and 22-33 under 35 U.S.C. 103(a) as being unpatentable over the teachings of Nagatomo in view of Alberts. However, this rejection is believed to be rendered moot with respect to claims 3-4, 10-11, and 17-18 in view of the above noted amendments to the independent claims upon which these claims depend. In this regard, the above noted remarks regarding Nagatomo and Alberts are applicable in response to this rejection, these references failing to disclose, teach, or otherwise suggest, alone, or in combination, the present invention as claimed.

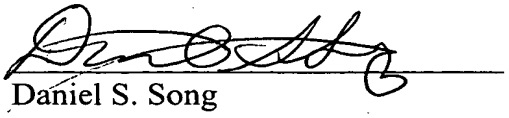
In addition, with respect to claims 22-33, it is again noted that independent claims 22, 26 and 29 recite the generation of a directed advertisement that *includes a portion of a response to a query*. The Examiner admits that Nagatomo does not teach this limitation. Further, as discussed in Applicants' response to the 35 U.S.C. § 102 rejection of claims 34-36, above, Alberts also does not teach such a limitation, or cure the other deficiencies of Nagatomo that were discussed above. However, to expedite

the prosecution of the present application, independent claims 22, 26 and 29 have been amended above to specifically recite that directed advertisement generated includes a portion of the response within the advertisement. Clearly, the cited Alberts reference, taken alone, or in combination with Nagatomo or other references of record, fails to disclose, teach, or otherwise suggest this limitation as claimed. Thus, the withdrawal of this rejection and the allowance of claims 3-4, 10-11, 17-18, and 22-33 are respectfully requested.

The Examiner also rejected claims 24, 32-33 under 35 U.S.C. 103(a) as being unpatentable over the teachings of Nagatomo, in view of Alberts and further in view of Chris Sherman ("Google Introduces Web Directory Using Netscape's Open Directory Project Data"). However, this rejection is also rendered moot in view of the above, these claims being dependent on an independent claim believed to be in proper condition for allowance. Therefore, the withdrawal of this rejection and the allowance of these claims are also respectfully requested.

In view of the foregoing, it is submitted that the present application is in condition for allowance and a notice to that effect is respectfully requested. However, if the Examiner deems that any issue remains after considering this response, he is invited to call the undersigned to expedite the prosecution and work out any such issue by telephone.

Respectfully submitted,



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